

specifically, at page 2, paragraph 3 of the Official Action, independent Claim 1 has been rejected under 35 U.S.C. Section 103(a) as being obvious over a combination of Herron (U.S. Patent No. 4,511,289) in view of Scott (U.S. Patent No. 2,573,498). At page 3, paragraph 4 of the Official Action, independent Claim 1 was also rejected under 35 U.S.C. Section 103(a) as being obvious over a combination of Winston (G.B. Patent No. 2,072,784) and Scott (U.S. Patent No. 2,573,498).

Since independent Claim 1 is the only independent claim in this application, only the prior art rejections of independent Claim 1 will be addressed. If independent Claim 1 is deemed to be allowable, the remaining dependent claims, each of which depend directly or indirectly from independent Claim 1 and thus include all features of the parent independent claim, will be allowable at least for the same reasons as independent Claim 1.

At pages 3 and 4 of the Official Action, in support of the rejections of independent Claim 1 at paragraphs 3 and 4 of the Official Action, the Examiner discusses the Scott patent which has been applied in both of the prior art rejections of independent Claim 1. The Official Action, in referring to Scott, states that "It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a varying material thickness, as taught by Scott, into a device as described by" Herron '289 or Winston, "in order to give more strength to the body and to give good contact force against the

wall of the hole where the embodiment is placed when is expanded". Applicant respectfully disagrees with this conclusion for several reasons. In the first instance, Applicant submits that varying the thickness of the material itself will not provide better wall contact, as the Examiner states. On the contrary, Applicant submits that there is no disclosure in the Scott patent itself which supports this conclusion.

More importantly, Applicant disagrees with the conclusion that the material disclosed by Scott will enhance the strength to the body, as stated in the Official Action. The Scott, patent at Column 3, lines 14 - 17, states:

"...Or the plug may be manufactured from metal, such as lead and like pliable material as well as other material suitable for interlocking with a wall...".

The single claim of the Scott patent is directed only to a "A non-metallic wall plug comprising...".

The materials specifically disclosed in both the specification and the claim of the Scott patent will not significantly improve the strength of a bolt if added to a bolt such as that disclosed in the Herron or Winston patents, both of which have been combined with the Scott patent to reject independent Claim 1 at paragraphs 3 and 4 of the outstanding Official Action.

It is axiomatic that references can only be combined to reject a claim if there is a suggestion in the prior art itself to make the combination. It is improper to use an Applicant's own disclosure as a guide for selectively combining different portions of different prior art references to reconstruct a claim. See, for example In re Fritch, 23 USPQ 2d 1780 (Fed. Cir. 1992); Micro-Chemical, Inc. v. Great Plains Chemical Co., Inc., 41 USPQ 2d 1238 (Fed. Cir. 1997); Orthopedic Equipment Co. v. United States, 217 USPQ 193 (Fed. Cir. 1983).

Applicant respectfully submits, that as a result of the teachings in the Scott patent which are contrary to the recitations in Applicant's independent Claim 1, there is clearly no suggestion in the prior art itself to combine the Scott patent with either the Herron patent or with the Winston G.B. patent in any manner rendering independent Claim 1 obvious when all positively recited features of the claim are considered in the patentability determination. Therefore, the only basis for combining the references in the manner proposed in the Official Action must be derived from use of Applicant's own disclosure as a guide for selective combination of different portions of the references. However, as noted above, a rejection of claims based on a selective hindsight combination of references is improper as a matter of law.

Applicant submits that independent Claim 1 is allowable over each combination of prior art references applied to reject it in

the final action. Dependent Claims 2 - 12, each of which depend directly or indirectly from independent Claim 1 and include all features of independent Claim 1, are believed to be allowable at least for the same reasons as independent Claim 1.

Applicant submits that all pending Claims 1 - 12 are in condition for allowance, and favorable action is respectfully requested.

Respectfully submitted,



Mark P. Stone
Reg. No. 27,954
Attorney for Applicant
25 Third Street, 4th Floor
Stamford, CT 06905
(203) 329-3355